

Application No.: 09/994,598

7

Docket No.: 425282000201

**REMARKS/ARGUMENTS**

Reconsideration is respectfully requested.

Claims 17-28 and 34-49 have been cancelled. Claims 54 and 55 have been added. Claims 1-16, 29-33, and 50-53 have been rejected. Claims 1-16, 29-33, and 50-55 are now pending.

With respect to all amendments and cancelled claims, Applicants have not dedicated or abandoned any unclaimed subject matter and moreover have not acquiesced to any rejections and/or objections made by the Patent Office. Applicants reserve the right to pursue prosecution of any presently excluded claim embodiments in future continuation and/or divisional applications.

**Claim Rejections under 35 U.S.C. § 112**

The Examiner has rejected claim 10 as indefinite. Claim 10 recites "the apparatus of claim 5, further comprising a sensor configured to measure the proximity of the applicator to a patient, wherein said sensor activates a switch when said applicator is coupled to the patient; and wherein said amplifier is turned off when said switch is activated." The Examiner states that "it would appear that claim 10 is incorrect in that the amplifier is turned off when the switch is deactivated." (Examiner's Emphasis).

Applicants respectfully traverse this ground for rejection. One of skill in the art would recognize that by activating a switch, another component may be *either* activated or deactivated. Activation of the *switch* does not mean that a separate component that is connected to the switch must be activated; the component can also be de-activated upon activating the switch.

Applicants respectfully request that this ground for rejection be withdrawn.

**Claim Rejections under 35 U.S.C. § 102(b)**

The Examiner has rejected claims 1, 5-9, 16, 29, 31-33, and 50-53 under 35 U.S.C. §102(b) as allegedly anticipated by Tepper, U.S. Patent No. 5,314,401.

sf-1648426 v3

Application No.: 09/994,598

8

Docket No.: 425282000201

**Tepper Does Not Anticipate the Presently Claimed Invention**

In order to anticipate under § 102(b), every element of the claimed invention must be identically shown in a single reference. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990). Because Tepper fails to show every element of the claimed invention, Tepper fails to anticipate claims 1, 5-9, 16, 29, 31-33, and 50-53.

**Claim 1 and claims depending therefrom**

Tepper fails disclose every element of independent claim 1 and those depending therefrom. Specifically, Tepper fails to disclose a detector disposed on the applicator, as recited in claim 1. Instead, Tepper teaches that the detector is disposed on control electronics, which are in a different location than the applicator.

Figure 1 depicts the control electronics and drive electronics at different locations separated by a cable. With reference to Figure 1, Tepper discloses that "encapsulated drive electronics 14 [are] located at one end of [a] transducer coil; and... control electronics module 16 [is] coupled to the drive electronics by a cable 17."

The Examiner asserts that the Tepper has "field sensing feedback" to the PEMF microprocessor. The field sense feedback, however, is housed within the control electronics, not within the drive electronics. Tepper states that "Figure 4 is a schematic block diagram of the control and drive electronics, which are physically located *respectively* in the control electronics module (16 in FIG. 1a), and within the encapsulated end of the transducer coil 12." (Column 7, lines 6-10, *Emphasis added*). Tepper describes the "control electronics 40" (Column 10, line 11) in Figure 4 within one set of dotted lines, and "drive electronics 60" (Column 8, line 6) within separate dotted lines to the right of the "control electronics." "Field sense amplifier" 52 is within the control electronics, not within the drive electronics. Since the control electronics are not "disposed on the detector," the field sensing feedback is not "disposed on the detector" as recited in claim 1.

sf-1648426 v3

Application No.: 09/994,598

9

Docket No.: 425282000201

Claims 29 and 50, and claims depending therefrom

Tepper fails disclose every element of independent claims 29 and 50, and those depending therefrom. Specifically, Tepper fails to disclose "a second circuit configured to vary the applied electromagnetic energy as a function of said response signal," as required by claim 29, or "varying the applied electromagnetic energy as a function of said response signal," as required by claim 50. Instead, Tepper discloses that "the PEMF processor causes appropriate monitoring data to be stored in the data memory 44, and will cause an alarm signal in the case of a malfunction." (Col. 8, lines 41-44.) Storing monitoring data, or causing an alarm signal based on a feedback signal, amounts only to measuring the signal, and does not vary the applied electromagnetic energy as a function of the response signal. Because Tepper fails to teach "a second circuit configured to vary the applied electromagnetic energy as a function of said response signal," the reference fails to meet this limitation of claims 29 and 50 and those depending therefrom.

Providing Feedback Does Not Inherently Provide Input for Controlling Output Fields.

The Examiner argues that "it is inherent that the feedback would provide input for controlling the output fields." Applicants strongly traverse this statement. The requirements for a rejection based on inherency are stated in M.P.E.P. § 2112, which describes the Examiner's burden in making such a rejection:

In relying on the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.

M.P.E.P. § 2112 (emphasis in original).

Moreover, "the fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic." *Id.* (quoting *In re Oelrich*, 212 USPQ 323, 326 (CCPA 1981).

In the present case, the Examiner has failed to meet the requisite burden of showing that varying the applied electromagnetic energy as a function of a response signal necessarily flows from Tepper. As discussed previously, Tepper only discloses storing monitoring data, or causing an alarm signal based on a feedback signal. Based on this teaching, it hardly follows that the applied

sf-1648426 v3

Application No.: 09/994,598

10

Docket No.: 425282000201

electromagnetic energy is necessarily varied as a function of the response signal. The possibility that the applied electromagnetic energy may be varied is insufficient to establish inherency.

Applicants respectively request that this ground for rejection be withdrawn.

**Claim Rejections under 35 U.S.C. § 103(a)**

The Examiner has rejected claims 2-4 and 30 under 35 U.S.C. § 103(a) as allegedly unpatentable over *Tepper*. The Examiner has also rejected claims 10-15 over *Tepper* in view of *Singh* (U.S. Patent No. 4,619,264).

35 U.S.C. § 103(a) requires that "differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains." 35 U.S.C. § 103(a). The prima facie case must satisfy three requirements: 1) the references must teach or suggest all the claim limitations; 2) the prior art combined with general knowledge must include a suggestion or incentive to modify or combine the references; and 3) the modification or combination must have a reasonable chance of success.

**A. Claims 2-4 and 30 are not obvious over *Tepper*.**

First, *Tepper* fails to meet every limitation of claims 2-4. Claims 2-4 depend from claim 1, and thereby include all limitations of claim 1. As previously discussed, *Tepper* fails to disclose a detector disposed on the applicator, as required by claim 1. The Examiner has therefore failed to meet every limitation of claims 2-4.

Second, *Tepper* fails to meet every limitation of claim 30. Claim 30 depends from claim 29, and thereby includes all limitations of claim 29. As previously discussed, *Tepper* fails to disclose "a second circuit configured to vary the applied electromagnetic energy as a function of said response signal," as required by claim 29. The Examiner has therefore failed to meet every limitation of claim 30.

Because *Tepper et al.* fail to teach every limitation of claims 2-4 and 30, *Tepper* fails to render the claims obvious.

sf-1648426 v3

Application No.: 09/994,598

11

Docket No.: 425282000201

**B. Claims 10-15 are not obvious over Tepper in view of Singh et al.**

The Examiner has rejected claims 10-15 over Tepper in view of Singh. Claims 10-15 depend from independent claim 1.

**Applicants' Response**

The references, taken either separately or together, fail to meet every limitation of the claims. Rejected claims 10-15 depend from claim 1, and thereby include all limitations of claim 1. As previously discussed, Tepper fails to disclose a detector disposed on the applicator, as required by claim 1. Singh et al. fail to compensate for this deficiency. The Examiner has therefore failed to meet every limitation of rejected claims 10-15.

The Examiner has failed to provide the requisite prima facie case for obviousness. Applicants respectfully request that this ground for rejection be withdrawn.

sf-1648426 v3

Application No.: 09/994,598

12

Docket No.: 425282000201

**CONCLUSION**

In light of the above amendments and remarks, Applicants believe that this case is now in condition for allowance. Should there be any issues that remain unresolved, the Examiner is encouraged to telephone the undersigned.

In the unlikely event that the transmittal form is separated from this document and the Patent Office determines that an extension and/or other relief is required, Applicants petition for any required relief including extensions of time and authorize the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to Deposit Account No. 03-1952 referencing 425282000201. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

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Respectfully submitted,

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sf-1648426 v3